

REMARKS

Claims 22-32, 34-45, 49-57, and 60 are pending in the Application and all stand rejected in the Office action mailed March 22, 2010. Claims 50-57 and 60 have been amended. Claims 22, 36, and 50 are independent claims from which claims 23-32, 34, and-35, claims 37-45 and 49, and claims 51-57 and 60 depend, respectively. Applicants respectfully request reconsideration of pending claims 22-32, 34-45, 49-57, and 60, in light of the remarks set forth below.

The Applicants note that a goal of patent examination is to provide a prompt and complete examination of a patent application.

It is essential that patent applicants obtain a prompt yet complete examination of their applications. Under the principles of compact prosecution, each claim should be reviewed for compliance with every statutory requirement for patentability in the initial review of the application, even if one or more claims are found to be deficient with respect to some statutory requirement. Thus, USPTO personnel should state all reasons and bases for rejecting claims in the first Office action. Deficiencies should be explained clearly, particularly when they serve as a basis for a rejection. Whenever practicable, USPTO personnel should indicate how rejections may be overcome and how problems may be resolved. **A failure to follow this approach can lead to unnecessary delays in the prosecution of the application.**

M.P.E.P. §2106(II) (emphasis added).

As such, the Applicants assume, based on the goals of patent examination noted above, that the current Office Action sets forth “all reasons and bases” for rejecting the claims.

Amendments to Claims

Claims 50-57 and 60 have been amended as shown above solely in response to a specific requirement of the Office. Applicants respectfully submit that the amendments to claims 50-57 and 60 do not add new matter.

Rejection of Claims

Claims 50-57 and 60 were rejected under 35 U.S.C. §101. Claims 22-24, 29-32, 34-37, 42-45, 46, 49, 50, 54-57, and 60 were rejected on the grounds of nonstatutory obviousness-type double patenting over claims 1-25 of U.S. Patent No. 6,850,510 in view of claims 1-21 of U.S. Patent No. 5,726,984 and Henley, *et al.* (US 5,526,353, "Henley") and Chan, *et al.* (US 5,550,861, "Chan") and Sharman, *et al.* (US 5,774,854, "Sharman"). Claims 25, 26, 38, 39, 51, and 52 were rejected on the grounds of nonstatutory obviousness-type double patenting over claims 1-25 of U.S. Patent No. 6,850,510 and claims 1-21 of U.S. Patent No. 5,726,984 in view of Henley, Chan, Sharman, and Heath, *et al.* (US 5,231,646, "Heath"). Claims 27, 28, 40, 41, and 53 were rejected on the grounds of nonstatutory obviousness-type double patenting over claims 1-25 of U.S. Patent No. 6,850,510 and claims 1-21 of U.S. Patent No. 5,726,984 in view of Henley, Heath, Sharman, Chan, and Avery, *et al.* (US 5,287,384, "Avery"). Applicants respectfully traverse the rejections.

I. Rejection Of Claims 50-57 And 60 Under 35 U.S.C. §101

The Office action rejected claims 50-57 and 60 under 35 U.S.C. §101 stating, at page 3, that "the claimed invention is directed to non-statutory subject matter because, in claim 50, lines 1-2 the limitation of "A computer-readable storage having stored

thereon a computer program." covers both statutory and non-statutory subject matter because the data stored on the storage medium can be transitory in nature. Therefore in order to comply with the rules of Interim Examination Instructions for Evaluating Subject Matter Eligibility Under 35 USC 101, claims 50-57,60, must be modified to recite as "A non-transitory computer-readable storage..." Applicants respectfully disagree. Nevertheless, Applicants have amended claims 50-67 and 60 as shown and described above, as required by the Office. Applicants respectfully submit, therefore, that claims 50-57 and 60 are directed to statutory subject matter, as defined by the Office, and request that the rejection of claims 50-57 and 60 under 35 U.S.C. §101 be reconsidered and withdrawn.

II. Non-Statutory Obviousness Type Double Patenting

Applicants respectfully submit that the rejections of all of claims 22-60 on the grounds of nonstatutory obviousness-type double patenting are based upon claims 1-25 of U.S. Patent No. 6,850,510 in view of claims 1-21 of U.S. Patent No. 5,726,984. Applicants do not agree with the Examiner's rejection. Nevertheless, in an effort to move the Application to allowance, Applicants are submitting a Terminal Disclaimer in compliance with 37 C.F.R. 1.321(c), disclaiming the terminal part of this application that extends beyond October 5, 2015, thereby removing U.S. Patent No. 6,850,510 from the prior art, to obviate the double patenting rejection. Applicants respectfully submit that the obviousness-type double patenting rejection is overcome.

Conclusion

In general, the Office Action makes various statements regarding the claims of the Application and the cited references that are now moot in light of the above. Thus, Applicants will not address such statements at the present time. However, Applicants expressly reserve the right to challenge such statements in the future should the need arise (e.g., if such statements should become relevant by appearing in a rejection of any current or future claim).

The Applicants believe that all of pending claims 22-32, 34-45, 49-57, and 60 are in condition for allowance. Should the Examiner disagree or have any questions regarding this submission, the Applicants invite the Examiner to telephone the undersigned at (312) 775-8000.

A Notice of Allowability is courteously solicited.

The Commissioner is hereby authorized to charge any fees required by this submission to the Deposit Account of McAndrews, Held & Malloy, Ltd., Account No. 13-0017.

Respectfully submitted,

Dated: June 22, 2010
McAndrews, Held & Malloy, Ltd.
500 West Madison Street, 34th Floor
Chicago, Illinois 60661
(312) 775-8000

By /Kevin E. Borg/
Kevin E. Borg
Agent for Applicants
Reg. No. 51,486